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EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

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06/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/045,089

Applicant(s)

GINSBURG ET AL.

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

The examiner for this application has changed. Please indicate Examiner Jason Borlinghaus as the examiner of record in all future correspondences.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsythe in view of Hotz.

Forsythe teaches a method and system for selecting and purchasing media advertising.

With respect to claim 1, Forsythe teaches a revenue maximization system which determines a price for units of inventory based on predetermined pricing considerations

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wherein said units are advertising opportunities (see for example column 6, line 48 through column 7, line 5). Applicant argues in the Remarks with the amendment filed 6/8/06 that a cost-per-spot and a cost-per-point, as previously relied upon by Examiner focus on the cost of a unit of advertising versus the price charged. Examiner finds this argument persuasive and thus submits the cited portions of Forsythe which teaches a rate request and the submission of a rate from a media outlet. It is the Examiner's position that such a manual operation (e.g. email or fax to the media outlet and then submission of the rate from the media outlet via a rate submission form) represents Applicant's revenue maximization system it allows the system to "determine a price for said units based on predetermined pricing considerations."

It is further the position of the Examiner that the media outlet inherently attempts to maximize their revenue when submitting a rate/price. There is simply no other reason a business would submit a price except in an attempt to maximize their revenue. Therefore under the broadest reasonable interpretation Forsythe teaches Applicant's revenue maximization system.

With respect to claim 1, Forsythe teaches a central information storage system which generates scenarios wherein various combinations of units are grouped together to meet a buyer's criteria wherein the buyer's criteria includes number of people and frequency people will be exposed to the advertisement units (see for example column 7, lines 5-35 and 56-57).

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Forsythe further teaches a scenario planner to display various scenarios generated by the central information storage system (see for example column 7, lines 15-18).

With respect to claim 1, Forsythe does not specifically teach a performance measurement system for measuring performance of a medium in which the units are used. Examiner notes here that one of ordinary skill in the art would recognize that the invention of Forsythe requires some sort of performance measurement system in order to properly generate a cost-per-spot.

Hotz teaches Market research companies, exemplified by "The Arbitron Company", "ACNielsen Company" and "Media Metrix" and "NetRatings" can be most generally described as providing statistical surveys of consumer behavior which includes; radio listening, television viewing, Internet usage, consumer purchasing and demographic data. This data can be used for setting advertising rates for radio and television and for tracking consumer behavior with respect to a particular company or product (see column 1, lines 57-66).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Forsythe to specifically include the performance measurement system for measuring performance of a medium in which the units are used as taught by Hotz in order to properly generate the cost-per-spot of Forsythe.

Forsythe further teaches the predetermined pricing considerations include category of buyer (see for example column 1, lines 29-31), unsold units (see for example column 3, line 7) and budget.

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Forsythe further teaches wherein the buyer's criteria further includes the desired budget for purchase of units and performance measurements (see for example column 7, lines 55-57).

Applicant further claims that the claimed revenue maximization system utilizes functions of sell-out forecasting, revenue forecasting, fuzzy rules and price adjustment as well as economic factors which influence demand and various measurement noises are filtered out of these factors. Examiner notes that these features are all included within system such as TAPSCAN, TVSCAN, and the other software noted from SMARTPLUS, Strata Software, COREMedia Systems, Inc., Telmar and SQAD and SPARC. (see column 2, lines 17-37).

Examiner notes that claims 8-21 are substantially similar to claims 1-7 and therefore are unpatentable as obvious in view of the rejection of claims 1-7 as presented above. Applicant is reminded that any argument in contrast to this statement is an indication of patentably distinct subject matter and may require a restriction requirement.

Response to Arguments

Applicant's arguments filed 2/16/07 have been fully considered but they are not persuasive.

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Regarding Applicant's assertion that the prior art references fail to disclose or suggest "a revenue maximization system where price is determined for units based on pre-determined pricing considerations," Examiner respectfully disagrees.

Forsythe discloses:

The System generates an e-mail or facsimile that is sent to the selected media outlets with the rate request information 122 (FIG. 4). For example, with broadcast media such as radio, television and cable, the outlets will be given the following information with which to submit its rates: flight period, dayparts, days of week, excluded programming or stations, category of advertiser, respond by date information and comments. (see col. 6, lines 48 – 55).

Examiner asserts that Forsythe discloses a revenue maximization system in which a price (rate) is determined for units (advertising spots) based on pre-determined pricing considerations (e.g. flight period, dayparts, days of week, excluded programming or stations, category of advertiser). Additionally, as stated by the previous Examiner, it would be inherent within the determination of said rates by the media outlets that such determination would be based upon a goal of revenue maximization, as such motivation would be a business imperative.

Applicant attempts to distinguish Forsythe from the instant application, as pricing in Forsythe "is done by humans." However, whether such pricing is a manual or automated method is immaterial, as it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *Dann v. Johnston*, 425 US 219, 227-30, 189 USPQ 257, 261 (1976); *In re Venner*, 120 USPQ 192 (CCPA 1958).

Regarding Applicant's assertion that the prior art references fail to disclose or suggest "wherein said predetermined pricing considerations includes at least three considerations selected from the group consisting of total number of unsold units, category of buyer attempting to purchase said units, the buyer's history in purchasing similar units, and budget of a seller of the units," Examiner respectfully disagrees.

Forsythe discloses a purchaser of advertising opportunities completing a SMART FORM (see fig. 8A – 8D). The SMART FORM solicits information such as category (product or service category) of buyer attempting to purchase said units, the buyer's history in purchasing similar units (what other media are they currently using), and budget of a seller of the units (buyer's budget available for use by the seller). (see fig. 8A – 8D). While Forsythe does not explicitly state that such collected information corresponding is utilized in the pricing of units, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Forsythe to allow usage of such collected information for pricing as a seller's assessment of a buyer's experience, knowledge and financial means would be beneficial for generation of customized prices which would maximize revenue.

Applicant attempts to distinguish Forsythe from the instant application, as Applicant asserts that Forsythe is directed to "an advertising brokering system" and "does not require disclosure of who is requesting advertising." However, "does not require disclosure" is not the same as "does not disclose," for information collected concerning the advertising buyer could be disclosed and, based upon Forsythe, is

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disclosed to media outlets (e.g. category of advertiser, comments – see col. 6, lines 48 – 55).

Additionally, Forsythe discloses:

BroadcastSpots.com is an online media service that offers unsold broadcast inventory to media buyers at discounted rates. BroadcastSpots.com serves as a catalog by posting remnant media inventory and rates for buyers. (see col. 3, lines 6 – 10).

Examiner asserts that Forsythe, therefore, discloses a system wherein predetermined pricing considerations includes the group consisting of total number of unsold units (unsold broadcast inventory).

Applicant attempts to distinguish Forsythe from the instant application, as the above-cited portion is from the Background section of the Forsythe patent and not from the section that discloses the patented method/system as envisioned by Forsythe. However, prior art is applicable for all it discloses and the fact that cited prior art was obtained from the Background section does not invalidate or diminish its disclosure.

Regarding Applicant's assertion that the prior art references fail to disclose or suggest "a central information storage system for receiving information from said performance measurement system and revenue maximization system to generate scenarios wherein various combinations of units are grouped together to meet a buyer's criteria wherein said buyer's criteria includes a number of people and frequency people will be exposed to the advertisement units,"

Examiner respectfully disagrees.

Forsythe discloses:

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After the System receives the rate submission page from the media outlet, it creates a schedule using a media planning module that interfaces with audience ratings and qualitative data 123 (FIG. 1). In a preferred embodiment, the System creates a "shell" schedule that is based on buying criteria from the Smart Form that includes customer demographics, budget or number of units requested (newspaper and outdoor), and for broadcast media, frequency or reach levels, selected dayparts and flight dates (start and finish dates of schedule) 126 (FIG. 5). The rate information is then entered into media software such as TAPSCAN.RTM. or TVSCAN.RTM. or similar software 128 and schedules are generated based on the derived parameters 130 (FIG. 5).

Once the schedules are generated, the System converts the schedule to a simplified format and applies a simplified efficiency rating system to the schedule 125 (FIG. 1). The simplified rating methodology evaluates the performance of each schedule in reaching the advertiser's target customer and the degree of cost efficiency. (see col. 7, lines 6 – 25).

Examiner asserts that Forsythe discloses a central information storage system, as it is inherent that a computer system has some storage capacity, for receiving information from said performance measurement system (module providing audience ratings and qualitative data) and revenue maximization system (rate submission page) to generate scenarios (schedule) wherein various combinations of units (number of units requested for newspaper and outdoor units) are grouped together (in a schedule) to meet a buyer's criteria (submitted on the SMART FORM) wherein said buyer's criteria includes a number of people and frequency (frequency or reach levels) people will be exposed to the advertisement units.

Applicant attempts to distinguish Forsythe from the instant application, as Applicant asserts that Forsythe presents to the advertiser only "presented with the schedule submitted by the media outlet", such schedule not present various combinations of units grouped together to meet buyer criteria. However, Forsythe discloses "In a preferred embodiment, the System creates a "shell" schedule

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that is based on buying criteria,” establishing that the schedule is not merely being passed from the media outlet to the advertiser but is being generated based upon the buyer’s criteria. Such buyer criteria includes “number of units requested (newspaper and outdoor), and for broadcast media, frequency or reach levels, selected dayparts and flight dates (start and finish dates of schedule)” and such desired units are combined and grouped together into a schedule.

Regarding Applicant’s assertion that prior art references fail to disclose or suggest an inventory management system, Examiner asserts that such claim limitations(s) have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *See In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding Applicant’s further assertions, all argument(s) and/or rationale(s) set forth above with respect to earlier addressed Claim 1, are hereby incorporated and/or reapplied so as to apply to remaining pending Claims where applicable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

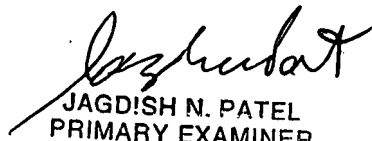
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMB

May 23, 2007


JAGDISH N. PATEL
PRIMARY EXAMINER